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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,362	03/01/2002	Qi Jia	UNI19	7281

25871 7590 03/24/2004
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EXAMINER

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ART UNIT PAPER NUMBER

1654

DATE MAILED: 03/24/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 2

Application Number: 10/091,362
Filing Date: March 01, 2002
Appellant(s): JIA ET AL.

Rosemary Kellogg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/29/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 4, 7, 22, 24, 25, 26, 27, 32, 33, 34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,264,995	Newmark et al.	7-2001
6,290,995	Xinxian	9-2001
6,475,530	Kuhrts	11-2002
6,391,346	Newmark et al.	5-2002
6,387,416	Newmark et al.	5-2002

Chen et al., Biochemical Pharmacology, 61, 2001, 1417-1427.

Chi et al., Biochemical Pharmacology, 61, 2001, 1195-1203.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1, 4, 7, 24-26, 32-34 are rejected under 35 U.S.C. 102(a) as being anticipated by Chi et al. (see title, abstract) or Chen et al. (see title, abstract, page 1418, section 2.4).

The references each teach that an extract from *Scutellaria baicalensis* is administered to a patient to inhibit or suppress COX-2.

Claims 1, 4, 7, 24-26, 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Xinxian (abstract), Newmark et al. '995 (abstract), Newmark et al. '346 (abstract, col. 2, lines 45-46), Newmark et al. 416 (abstract, col. 2, lines 42-43), or Kuhrts (abstract, col. 6, lines 22-37).

The references each teach that an extract from *Scutellaria baicalensis* is administered to a patient to inhibit COX-2 or treat cancer which is also regulated by COX-2.

Claim Rejections - 35 USC § 103

Claims 1, 4, 7, 22, 24-27, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Chi et al., Chen et al., Xinxian, Newmark et al. '995, Newmark et al. '346, Newmark et al. '416 or Kuhrts.

The teachings of the references are above. The amounts used are simply the choice of the artisan to use in an effort to optimize the desired results. The range of 2.0 to 200 mg/kg of body weight is a very broad range and while the references may not use the same measurements of the amount of the extract as appellants do, it is clearly within the purview of the skilled artisan to use such broad ranges since such broad ranges would clearly encompasses so many different amounts that one could use in administering this well known plant extract for a well known use.

(11) *Response to Argument*

Appellant first argues that Chi et al. (Chi) does not teach that their extract of the claimed plant extract inhibits the COX-2 enzyme. Fact is, Chi teaches that wogonin suppresses the activity of COX-2, see title. In the abstract Chi more specifically states that wogonin inhibited COX-2 directly.

Thus, Chi does meet the claimed invention.

Next, Appellant argues that Chen et al. (Chen) does not teach that their extract of the claimed plant extract inhibits the COX-2 enzyme. Fact is, Chi teaches that wogonin suppresses the activity of COX-2, see title Fact is, Chen teaches that wogonin, baicalin and baicalein inhibit COX-2, see title.

Appellant argues that some of the alkaloid extracts are taught to inhibit COX-2 while others are not, but all that is needed to meet the claims is that one of the claimed alkaloids inhibit COX-2.

Appellant next argues that Xinxian does not teach that their extract of the claimed plant extract inhibits the COX-2 enzyme. Fact is, Xinxian teaches that the extract is known to treat cancer, see abstract. Since it is well known that COX-2 is involved in pain, arthritis and cancer, if the cancer is inhibited so is the COX-2 activity inherently. Thus, the reference does teach that COX-2 is inhibited.

Appellant argues that the Newmark references do not teach that the extract can be used to inhibit COX-2. In the abstracts and in col. 2 as noted above, the extracts are known to inhibit COX-2. Appellant argues that there are other ingredients in the compositions of the references but the claimed invention uses the word, "comprising", thus there is no limitation in the claims that require only the claimed extract to be used in the claimed method.

Appellant argues that Kuhrt does not teach dosages or how the extract is used. First of all, on col. 6, lines 22-36 it is clear that the claimed extract is known to be a COX-2 inhibitor. It is clear that the extract is a COX-2 inhibitor. Under this 35 USC 102 rejection the amounts are not claimed. It is clear from the reference that the extract is a COX-2 inhibitor and thus meets the claims.

Appellant argues the same for this 35 USC 103 rejection as he did for the 35 USC 102 rejections. Appellant once again states that the references do not teach that the extract can be used to inhibit COX-2. This is simply not true. As noted above, each

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reference teaches one of skill in the art that the claimed extract is well known in the art to be used to inhibit COX-2.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

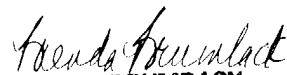


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Primary Examiner
Art Unit 1654

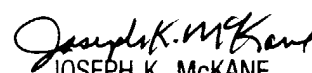
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